



UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

APR 14 2011

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

VEDDER PRICE P.C.
222 N. LASALLE STREET
CHICAGO IL 60601

PCT LEGAL ADMINISTRATION

In re Application of:	:	
NORDHOFF, Eckhard, et al.	:	DECISION ON THIRD RENEWED
U.S. Application No.: 10/576,644	:	REQUEST UNDER 37 CFR
Int'l Application No: PCT/EP2004/011878	:	1.497(d) AND SECOND
Int'l Filing Date: 20 October 2004	:	RENEWED PETITION FOR
Priority Date: 23 October 2003	:	REVIVAL UNDER
Attorney's Docket No.: 39412.00.0002	:	37 CFR 1.137(b)
For: METHOD AND DEVICES FOR	:	
DEPOSITING SAMPLES ON AN	:	
ELECTRICALLY SHIELDED	:	
SUBSTRATE	:	

This decision is issued in response to the "Transmittal Letter For Second Renewed Petition Under 37 C.F.R. 1.136(b) And Renewed Request Under 37 C.F.R. 1.497(d)" filed 17 February 2011. Applicants have previously filed the petition fee required for the petition for revival under 37 CFR 1.137(b) and the processing fee required with respect to the request under 37 CFR 1.497(d).

BACKGROUND

The procedural background for the present application was set forth in the decisions mailed on 08 May 2008, 10 September 2009, and 17 November 2010.

The decision mailed 08 May 2008 dismissed without prejudice applicants' request under 37 CFR 1.497(d) to add four additional inventors to the present application. Specifically, the decision indicated that applicants had not provided the consent of the assignee required for such a request to be grantable, and that the filed declaration was an unacceptable compilation of multiple documents. The decision provided an extendable two-month period for applicants to file a request for reconsideration (accompanied by the additional required materials).

Applicants did not file a response to the 08 May 2008 decision during the available response period. Accordingly, the present application became abandoned as of midnight on 08 July 2008.

On 16 March 2009, applicants filed a petition for revival, accompanied by a renewed request to correct inventorship under 37 CFR 1.497(d) and a revised declaration.

The decision mailed on 10 September 2009 dismissed without prejudice applicants' renewed request under 37 CFR 1.497(d), indicating that the consent of the assignee filed by applicants was defective because it was not accompanied by a statement in compliance with 37 CFR 3.73(b) and that the revised declaration was defective because it failed to identify the citizenship of all of the inventors. The decision also dismissed without prejudice the petition for revival under 37 CFR 1.137(b) because applicants had failed to provide the "required reply," that is, the materials required to satisfy the final element of a grantable request under 37 CFR 1.497(d) to correct inventorship and an acceptable declaration executed by the inventors. The decision again provided an extendable two-month period for applicants to file a request for reconsideration (accompanied by the additional required materials). Applicants did not file a response to the 10 September 2009 decision during the available response period.

On 09 September 2010, applicants filed a Renewed Petition To Revive Unintentionally Abandoned Application Under 37 CFR 1.136(b) And Renewed Request Under 37 CFR 1.497(d), accompanied by a second revised declaration.

The decision mailed on 17 November 2010 again dismissed without prejudice applicants' renewed request under 37 CFR 1.497(d), indicating that applicants had not provided acceptable declarations from each of the inventors. The decision also dismissed without prejudice the renewed petition for revival under 37 CFR 1.137(b) because applicants had failed to provide the "required reply."

On 17 February 2011, applicants filed the third renewed request under 37 CFR 1.497(d) and second renewed petition for revival under 37 CFR 1.137(b) considered herein.

DISCUSSION

1. Third Renewed Request To Correct Inventorship (37 CFR 1.497(d))

The present submission includes complete declarations executed by each of the inventors, including the four inventors to be added under 37 CFR 1.497(d) (Christine LUBBERT, Antonin SCHENK, Holger EICHKOFF, and Martin HORN). As discussed in the prior decision, applicants have previously submitted the other requirements for a grantable request under 37 CFR 1.497(d), that is, statements of non-deceptive intent from the persons to be added as inventors, the applicable processing fee, and the consent of the assignee to the requested change in inventorship.

Applicants have now satisfied all the outstanding requirements for a grantable request to correct inventorship under 37 CFR 1.497(d). The requested addition of Christine LUBBERT, Antonin SCHENK, Holger EICHKOFF, and Martin HORN as additional inventors of record in the present application is therefore appropriately granted.

In view of the correction of inventors, the declarations filed with the present renewed petition on 17 February 2011 may be accepted under 37 CFR 1.497.

2. **Second Renewed Petition For Revival (37 CFR 1.137(b))**

As stated above, applicants have now submitted the materials required to satisfy the final element of a grantable request under 37 CFR 1.497(d) to correct inventorship and acceptable declarations in compliance with 37 CFR 1.497. These materials satisfy the "required reply" element of a grantable petition for revival under 37 CFR 1.137(b).

Applicants have previously submitted the required petition fee for the petition for revival, and the present renewed petition includes a statement that "the entire delay in filing the required reply to the decision mailed on September 10, 2009, until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." This statement, in combination with the statements of unintentional delay included in the earlier petitions for revival filed on 16 March 2009 and 09 September 2010, satisfies the requirements of 37 CFR 1.137(b)(3).

Based on the above, applicants have now satisfied the requirements for a grantable petition for revival under 37 CFR 1.137(b). The renewed petition is therefore appropriately granted.

CONCLUSION

Applicants' renewed request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**.

The inventorship of record herein is corrected to add Christine LUBBERT, Antonin SCHENK, Holger EICHKOFF, and Martin HORN as additional inventors of record.

In view of the correction of inventorship, the executed declarations filed on 17 February 2011 (which include the added inventors) may be accepted under 37 CFR 1.497.

The renewed petition for revival under 37 CFR 1.137(b) is **GRANTED**

This application is being referred to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 17 February 2011.

/RichardMRoss/

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296